

REMARKS

I. Introduction

Claims 7-14 are now pending in the present application. Claims 7, 8, 13 and 14 have been amended. Applicants hereby respectfully request reconsideration in view of the following explanation.

Applicants note with appreciation the acknowledgment of the claim for foreign priority.

Applicants thank the Examiner for considering the previously filed Information Disclosure Statement, PTO 1449 paper and cited references.

II. Objection to the Specification

The specification was objected to because the abstract was too long. It is noted that the Substitute Specification received by the Office on August 24, 2006, provides an abstract of acceptable length, i.e., fewer than 150 words and fewer than 15 lines. Withdrawal of the objection is respectfully requested.

Rejection of Claims 7 -14 under 35 U.S.C. §102(e)

Claims 7-14 were rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 7,168,039 ("Bertram"). Applicants respectfully submit that the rejection should be withdrawn for at least the following reasons.

In order to reject a claim under 35 U.S.C. §102(e), the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (See Scripps Clinic & Research Foundation v. Genentech, Inc., 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter. (See Akzo, N.V. v. U.S.I.T.C., 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)). To the extent that the Examiner may be relying on the doctrine of inherent disclosure, the Examiner must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent

characteristics necessarily flow from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int’f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherence of that result or characteristic.

Amended claim 7 recites, in relevant parts, “providing text information to be output, wherein the text information includes at least one information element, the at least one information element being divided into at least two component fields, and wherein the at least two component fields include at least an information body and at least one of an information prefix and an information suffix of the information element, and wherein at least one of the information body, information prefix and information suffix having a predetermined abbreviated equivalent; and . . . wherein text information outputted on the display unit includes: a) full representation of the at least one information element if the predetermined display is sufficient for the full representation; and b) the abbreviated equivalent of the at least one of the information body, information prefix and information suffix if the predetermined capacity is insufficient for full representation of the at least one information element.” Amended claim 14 recites substantially similar features as the above-recited features of claim 7.

In support of the rejection of claim 7, the Examiner makes the following interpretations: a) “column” of the data table disclosed in Bertram is equivalent to the “information element”; b) each “row” of the data table disclosed in Bertram is equivalent to the claimed “component”; and c) “column heading” of Bertram is equivalent to the claimed “abbreviated equivalent.” (See Office Action, p. 4). Furthermore, with respect to the features previously recited in claim 13 (now incorporated in amended claims 7 and 14), the Examiner contends that “Bertram discloses the components include at least an information body and at least one of an information prefix and an information suffix, each . . . having an abbreviated equivalent,” because Bertram allegedly discloses “the words are abbreviated keeping at least a part of the first and consequent words” (citing col. 7, l. 55 – col. 9, l. 32). However, these assertions made by the Examiner are not only contradictory and

unsupported by the actual disclosure of Bertram, but are also clearly different from the amended claim features, as explained below.

To the extent the Examiner is arguing that each **“row”** of the data table disclosed in Bertram is equivalent to the claimed **“component,”** and that **multiple rows** may be treated in aggregate as **an information body and at least one of an information prefix and an information suffix of the same information element,** the actual disclosure of Bertram clearly contradicts the Examiner’s interpretations: Bertram clearly indicates that **each row** includes data relating to a **different system** (e.g., system 10, 22, 24, 26 or 28, as shown in Figs. 2, 4 and 8; see Bertram, col. 4, l. 24-40; col. 8, l. 66 – col. 9, l. 7), which means that **multiple rows clearly cannot be treated** in aggregate as **an information body and at least one of an information prefix and an information suffix of the same information element.** More fundamentally, to the extent the Examiner is contending that data of **different rows** may somehow be treated as **an information prefix and an information suffix of the same information element,** this contention simply defies common logic, since **each row** includes data relating to a **different system.**

Independent of the above, to the extent the Examiner contends that “Bertram discloses **the components include** at least an **information body and at least one of an information prefix and an information suffix,** each . . . having an abbreviated equivalent” since Bertram allegedly discloses “the **words** are abbreviated keeping at least **a part of the first and consequent words,**” Applicants note that Bertram only discloses abbreviating **column headings.** To the extent the Examiner is implicitly contending that **abbreviated column headings** are equivalent to the claimed **information body and at least one of an information prefix and an information suffix of the same information element,** this implicit contention is clearly inconsistent with the Examiner’s concurrent contention that each **“column”** of the data table disclosed in Bertram is equivalent to the **“information element”** (“rows” of which column are allegedly equivalent to the claimed “components,” according to the Examiner).

Independent of the above, there is simply no suggestion in Bertram of “an information element being divided into **at least two component fields,** and wherein **the at least two**

component fields include at least an information body and at least one of an information prefix and an information suffix of the information element, and wherein at least one of the information body, information prefix and information suffix having **a predetermined abbreviated equivalent**.” Bertram merely discloses abbreviating **column headings** by removing characters of a particular character type (e.g., lower case vowels, lower case letters, and spaces) (see, e.g., col. 7, l. 55 – col. 8, l. 58), but there is clearly no suggestion of any “information element being divided into **at least two component fields**” or any **predetermined abbreviated equivalent**, let alone providing any **predetermined abbreviated equivalent of the at least one of the information body, information prefix and information suffix** of the same **information element**.

For at least the foregoing reasons, Bertram does not anticipate claims 7 and 14, as well as their dependent claims 8-13.

Conclusion

In view of the foregoing, it is respectfully submitted that pending claims 7-14 are in condition for allowance. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is respectfully requested.

Respectfully submitted,
KENYON & KENYON LLP



(R. NO.
36,197)

Dated: January 27, 2009

By: JONG LEE for Gerard Messina
Gerard A. Messina (Reg. No. 35,952)
One Broadway
New York, NY 10004
(212) 425-7200
CUSTOMER NO. 26646